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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,238	09/28/2005	Hideto Kamimura	278507US0PCT	4244
22850 7590 01/26/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER GOLOBOY, JAMES C				
ART UNIT 1797		PAPER NUMBER		
NOTIFICATION DATE 01/26/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/551,238

**Applicant(s)**

KAMIMURA ET AL.

**Examiner**

James Goloboy

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 10, 12-15, 18, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 12-15, 18, 21-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's amendments filed 10/9/09 overcome the rejections set forth in the office action mailed 7/14/09. However, the amended claims are rejected over the references of record.

***Claim Rejections - 35 USC § 103***

2. Claims 1-3, 10, 12-15, 18, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denpo in view of Bialas and Papay.

In paragraph 7, Denpo discloses a rolling device covered in a conductive lubricating oil with a volume resistivity below  $1 \times 10^7$  ohm-cm, within the range recited in claim 1. In paragraph 14, Denpo discloses that the lubricating oil can be an ester, as recited in claim 6, or an ether, as recited in claim 8. In paragraph 13 Denpo discloses that the composition advantageously comprises an antioxidant, as recited in claim 14. While Denpo does not specifically disclose the viscosity, viscosity index, pour point, or flash point of the lubricating oil, Denpo does disclose in paragraph 14 that the choice of lubricating oil is not particularly limited, and therefore implicitly discloses ranges of viscosities, viscosity indices, pour points, and flash points encompassing the claimed ranges. The differences between Denpo are the currently presented claims are:

i) In paragraph 10 Denpo discloses that the composition contains an surfactant which is effective as an antistatic agent, but does not disclose the specific antistatic agents recited in amended claim 1.

ii) Denpo does not disclose the inclusion of a phosphate-based friction modifier.

iii) Denpo does not disclose specific suitable ethers.

iv) The composition of Denpo does not further contain the reaction product of tetraethylenepentamine and stearic acid.

With respect to i), Bialas, in column 7 line 54 through column 8 line 33, teaches that antistatic agents for lubricants can be surfactants, including glycerol mono- or dioleates (column 7 lines 56-57) which are polyhydric alcohol partial esters as recited in amended claim 1, sulfosuccinates (column 8 lines 26-28), which are succinic acid derivatives as recited in amended claim 1 and newly added claim 16. The use of these surfactants/antistatic agents of Bialas in the composition of Denpo meets the limitations of claims 1-3, 6, 8, and 13.

With respect to ii), Papay, from column 46 line 51 through column 47 line 12, discloses suitable friction modifiers for use in lubricating compositions. In column 44 lines 23-36 Papay discloses that amine phosphates can be used as antiwear agents, as recited in component (C) in claim 1, and discloses specific amine phosphates meeting the limitations of claims 21-22. Papay further discloses numerous desirable additives for lubricating compositions meeting the limitations of claim 14.

With respect to iii), Egawa, in paragraphs 6-7, discloses an ether base oil which meets the limitations of the amended claim 1 as well as claim 10 when  $n$  is 0 (claim 10), or 0-8 (claim 9). Egawa discloses that the viscosity index is 150 or more, within the range recited in claim 1.

With respect to iv), Baba, from page 1 line 28 through page 2 line 3, discloses a lubricating composition having excellent anti-rust properties. On page 15 lines 22-25,

Baba discloses that the composition can be a bearing oil. On page 2 lines 24-26 Baba discloses that the composition comprises a polyalkylenepolyamide. In the examples on pages 17-21, Baba discloses polyalkylenepolyamides that are the reaction product of tetraethylenepentamine with mixtures of stearic and isostearic acid. These products therefore contain the antistatic additive recited in claims 1, 12, and 18.

It would have been obvious to one of ordinary skill in the art to include the surfactants/antistatic agents of Bialas in the composition of Denpo, as Bialas teaches that they are suitable antistatic agents for lubricating compositions. It would have been further obvious to include the phosphate friction modifiers and antiwear agents of Papay in the composition of Denpo, to adjust the friction between the lubricated parts and to reduce wear of the lubricated parts. It would have been obvious to use the ether of Egawa as the lubricating oil of Denpo as Egawa teaches that it is a suitable ether lubricating oil. It would have been obvious to include the additive mixture of Baba in the composition of Denpo, Papay, and Bialas, as Baba teaches that it is an effective antirust additive for bearing oil compositions. As the combined composition contains all the components required in claim 15, it is therefore capable of use as a bearing oil.

### ***Response to Arguments***

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. The new combination of references addresses all the limitations of the amended claims. Applicant also argues that the claimed composition gives unexpectedly superior results and points to table 2 of the specification. However, the

inventive compositions exemplified in the table are clearly not commensurate in scope with the claims, as they contain specific amounts of specific additives, while the claims do not limit the concentration of base oil or friction modifier, and recite a broad range for the concentration of antistatic agent.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797